



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,032	01/16/2002	Donald H. Lucast	56435US002	1581
32692	7590	03/19/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			YAO, SAMCHUAN CUA	
		ART UNIT	PAPER NUMBER	1733
DATE MAILED: 03/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/052,032	LUCAST ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) ____ is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date ____

- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____ .
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____ .

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, 25, 27-33, 44 and 50, drawn to a pressure sensitive adhesive (PSA) composition, article comprising the PSA, and a method of using a PSA. Independent claim 1 or 25 requires "... copolymerized ... unsaturated reinforcing monomer ... the pressure sensitive adhesive polymer includes covalently bonded quaternary ammonium functionality" (emphasis added; **A**).
 - II. Claims 16, 34, 41-42 and 45, drawn to a PSA composition, article comprising the PSA, and a method of using a PSA. Independent claim 16 requires "copolymerized quaternary ammonium monomer ..." (emphasis added; **B**).
 - III. Claims 17-20, 35-36 and 46-47, drawn to a PSA composition, article comprising the PSA, and a method of using a PSA. Independent claim 16 requires "copolymerized quaternary ammonium monomer ... copolymerized poly(alkylene oxide) (meth)acrylic acid ester monomer" (**B+C**) or independent claim 20 requires limitation **C** and antimicrobial agent (**B+C'**).
 - IV. Claims 21-24, 37 and 48-49, drawn to a PSA composition, article comprising the PSA, and a method of using a PSA. Independent claim 21 requires "at least one nonreactive poly(alkylene oxide) polymer" (**D**).

V. Claims 26, 40, and 51, drawn to a PSA composition, article comprising the PSA, and a method of using a PSA. Independent claim 26 requires "a *chlorhexidine-compatible pressure sensitive adhesive polymer*" (**E**).

The inventions are distinct, each from the other because of the following reasons:

- a) Inventions II and III are related as combination and subcombination. In the instant case, the combination as claimed recites particular characteristics of the subcombination, but there is evidence that the particular characteristics of the subcombination are not essential to the patentability of the combination. Characteristic of (for instance) "*copolymerized poly(alkylene oxide) (meth)acrylic acid ester monomer*" (**C**) can be used as a basis for showing that Subcombination does not constitute the sole distinguishing novelty in the combination.
- b) Groups I-V are directed to distinct composition. The patentability in the independent claims of each group is based on divergent features. For instance, claim 1 of Group I requires potentially patentable limitation **A**, but does not require limitation **B** recited in independent claim 16 in Group II or limitation **B+C** recited in independent claim 17 in Group III, and vice versa. The differences between these groups are critical and significant to the extent that the inventions constitute *prima facie* patentably distinct combinations, absent evidence to the contrary. This can readily and clearly be demonstrated by the side-by-side comparison of the independent claims, noted earlier. Similarities of the

independent claims are merely superficial, since certain significant limitations in one of the groups find no counterpart in the other group(s) and vice versa.

Presently, no claim is generic. **Rejoinder of non-elected groups will be considered, upon indication of allowable subject matter, depending on the basis thereof.**

2. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups (II-III) or IV or V, and vice versa; and, because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
3. Due the complexity of the restriction requirement, no attempt was made for Applicant to make a telephone election.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
03-16-04